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Attorney Ref. No. 012.P53013

AUG 24 2007

Patent Application No. 09/918,691

**REMARKS**

This response is a full and complete response to the Final Office Action mailed May 21, 2007. In the present Office Action, the Examiner has noted that claims 1-41 are pending, that claims 1-15 and 30-41 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,785,290 to Fujisawa et al. (hereinafter "Fujisawa"), that claims 16-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over various combinations of Fujisawa, U.S. Patent No. 6,049,550 to Baydar et al. (hereinafter "Baydar"), U.S. Publ. No. 2003/0081287 to Jannson et al. (hereinafter "Jannson").

In view of both the amendments presented above and the following remarks, it is submitted that the claims pending in the application are novel and nonobvious. It is believed that this application is in condition for allowance. By this response, reconsideration of the present application is respectfully requested.

**Claim Amendments:**

The assignee has amended claims 8 and 11-13 to correct typographical errors and claims 39 and 41 to combine features of these claims. Claims 1, 8, 11, 16, and 23 have been amended to add the word "structurally". Claims 30, 33, 36, and 39 have been amended to include the word "exactly". New claims 42-44 have been added. No new matter has been introduced.

**Claim Objections:**

The Examiner objects to claim 11 because "egress packets" should be replaced with "ingress packets". There is also an extra comma in claim 11.

The assignee has amended claim 11 to overcome the claim objections by changing "egress packets" with "ingress packets" in line 11, and removing the extra comma in line 17.

**Claim Rejections Under 35 U.S.C § 102(e)**

Claims 1-15 and 30-41 are rejected as being anticipated by Fujisawa. This

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rejection is respectfully traversed. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 citing *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." MPEP § 2131 citing *Continental Can Co. USA v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). Fujisawa does not teach each and every element of the rejected claims.

To expedite examination of the claims towards allowance, the assignee has amended claims 1, 8, and 11 to recite an egress/ingress undiverted packet buffer structurally coupled between the first packet diversion logic and the first packet insertion logic. Support for this amendment may be found in the Specification, for example, in FIG. 3 and its supporting text.

The Examiner rejected these claims by asserting that the first packet diversion logic and the first packet insertion logic read on Fujisawa's scheduler 16, that the egress/ingress undiverted packet buffer reads on Fujisawa's cell buffer 56/66, and that, even though the cell buffer 56 is not structurally coupled between the first packet diversion logic and the first packet insertion logic, it is functionally coupled between these elements (see the Examiner's *Response to Arguments*, page 22).

The amended claims, however, now include the *structurally coupled between* feature that the Examiner pointed out to not be taught by Fujisawa.

For at least the reasons discussed above, Fujisawa fails to anticipate claims 1-15. Thus, the assignee respectfully requests withdrawal of the rejection under 35 U.S.C. § 102(e) for these claims.

Claims 30, 33, and 36 recite a first divert logic coupled to said first and second

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storage structures to selectively route egress/ingress packets onto a selected exactly one of said first and second storage structures. Claim 39 has been amended with features from claim 41 to also include features similar to those of claims 30, 33 and 36.

The Examiner rejects claims 30, 33, and 36 by asserting that Fujisawa teaches selective routing onto a selected one of the first storage structure 56 and the second storage structure 44A. But, as Fujisawa teaches in FIG. 8D, cell buffer 56 and temporary RAM 44A are serially connected, and data packets cannot be routed onto temporary RAM 44A without first being routed onto cell buffer 56. Because, each of the claims 30, 33, 36, and 39 require routing onto a selected exactly one of the storage structures, Fujisawa fails to anticipate these claims by only being able to route data packets onto *both* cell buffer 56 and temporary RAM 44A.

For at least the reasons discussed above, Fujisawa fails to anticipate claims 30-41. Thus, the assignee respectfully requests withdrawal of the rejection under 35 U.S.C. § 102(e) for these claims.

Claim Rejections under 35 U.S.C. § 103(a)

Claims 16-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of Fujisawa, Baydar, and Jannson.

The Examiner is reminded that to successfully make a *prima facie* rejection under 35 USC § 103, the Examiner must show that Assignee's claimed subject matter would have been obvious to one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. See *KSR International, Co. v. Teleflex, Inc.*, 550 U.S. \_\_\_\_ (decided April 30, 2007). Some of the factors to consider in this analysis include the differences between the applied documents and Assignee's claimed subject matter, along with the level of skill associated with one of ordinary skill in the art pertinent to Assignee's claimed subject matter at the time it was made. See USPTO Memo entitled "Supreme Court decision on *KSR Int'l. Co., v. Teleflex, Inc.*"

(May 3, 2007). One way in which an Examiner may establish a prima facie case of unpatentability under 35 USC § 103 would be to show that three basic criteria have been met. First, the Examiner should show that the applied documents, alone or in combination, disclose or suggest every element of Assignee's claimed subject matter. Second, the Examiner should show that there is a reasonable expectation of success from the proposed combination. Finally, the Examiner should show that there was some suggestion or motivation, either in the applied documents themselves or in the knowledge generally available to one of ordinary skill in the art pertinent to the claimed subject matter at the relevant time, to modify the document(s) or to combine document teachings. The motivation or suggestion to make the proposed combination and the reasonable expectation of success should be found in the prior art, and should not be based on Assignee's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); See MPEP § 2142; 2143 - § 2143.03 (regarding decisions pertinent to each of these criteria). It is respectfully asserted that the Examiner has not met these standards.

The assignee has amended claims 16 and 23 to recite an egress undiverted packet buffer structurally coupled between the first packet diversion logic and the first packet insertion logic. Fujisawa fails to teach, show, or make obvious these limitations, as discussed above regarding claims 1, 8, and 11. Baydar and Jansson fail to make up for Fujisawa's shortcomings. Thus, the assignee submits that these references, individually or in combination, do not teach or suggest all the limitations of the aforementioned claims, and respectfully requests withdrawal of the rejection of these claims, as well as their dependent claims 17-22 and 24-29 under 35 USC § 103 (a).

It is noted that claimed subject matter may be patentably distinguished from the applied documents for additional reasons; however, the foregoing is believed to be sufficient to overcome the Examiner's rejections discussed above.

Further, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or

To: MAIL STOP RCE

From: Leslie Ray for Brian D. Wichtner

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acquiescence with those asserted positions since the Examiner's other positions are believed to be moot in light of the foregoing.

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**CONCLUSION**

In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application are in condition for allowance. Reconsideration and allowance of all the claims are respectfully solicited.

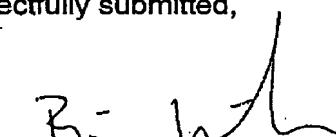
If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Brian Wichner at (503) 439-6500 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

In the event that there are any errors with respect to the fees for this response or any other papers related to this response, the Director is hereby given permission to charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account No. 50-3703.

Respectfully submitted,

Dated: 8/24/07

By:



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